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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,636	04/09/2004	Scott E. Williams	005127.00226	9029
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EXAMINER				
QUINN, RICHAE LEE				
ART UNIT		PAPER NUMBER		
3765				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,636

Applicant(s)

WILLIAMS ET AL.

Examiner

RICHALE L. QUINN

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32 and 34 - 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30, 32 and 34-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed on 11/29/2006 has been considered. Claims 1, 12, 24, 30, 32, 34, and 41 were amended. Claims 31 and 33 were cancelled. Claims 1 - 30, 32, and 34 - 48 are currently pending. The drawing rejection of 8/31/2006 has been obviated.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 4, 6, 7, 12 – 15, 17 - 21, 41 - 43, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Buonassissi (US 4,601,067). The device of Buonassissi discloses an apparel article, specifically a vest, for moderating body temperature (10), comprising a torso region (12, 14, 16) having a chest region and a back region, and a pair of side regions (24, 30), shoulder regions (Figure 1), a plurality of cavities on the front, back and side regions (36, 34), at least a portion of the shoulder region (32), and a fitting system (20, 22, 28, 26) extending at least partially around the torso region and having a substantially vertical direction through the chest area (20, 22). It is noted by the examiner that the fastening system (28, 26) is adjustable so that the sides (24, 30) may be in direct contact with each other and additional elements of the fitting system (20, 22) are located at the chest area. Thermal inserts, comprising water

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(Column 2, lines 19 –21) are inserted into the pockets (32, 34, and 36) and are located at an area around each of the side areas (34, 36) and near the top of the shoulder areas (32).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5, 16, 30, 31 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bounassissi in view of Steele et al. (US 5,146,625). The device of Bousassissi discloses a garment for wearing and moderating body temperature of an individual comprising selecting an article of apparel (10), refrigerating (column 2, lines 25 – 28) at least a portion of the article of apparel that includes cooling a plurality of inserts that are positioned within the cavities so that at least one of the cavities is positioned around the side areas of the torso (34, 36). In regard to method claims 30 and 31, the device of Bousassissi does not disclose a garment that is worn during first and second periods of time while participating in a first sedentary activity and a second non-sedentary activity and removing the garment. It is noted that the device of Bousassissi is capable of being worn during any type of physical activity performed by the person wearing the garment, such as walking vs. sitting. The recitation of performing

an activity relates to the person wearing the garment and not the garment itself and is therefore considered a functional recitation. It is understood that the garment can be removed at the discretion of the wearer. The combination of Buonassissi and Steele et al. meet all of the structural limitations claimed by applicant and is inherently capable of performing in method described by applicant. The device of Bounassissi substantially discloses the claimed invention but is lacking an insert having multiple chambers. The device of Steele et al. discloses a thermal insert for a vest having multiple chambers within (52) which are cooled in a freezer (Column 3, lines 65 – 69) to keep the wearer cold during activities (Column 4, lines 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Bounassissi by incorporating multiple chambers as taught by Steele et al. in order to allow easier use of flexing (Column 4, lines 43 – 45).

5. Claims 8 – 11, 22 – 25, 27 - 29, 34 – 40, and 46 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buonassissi in view of The Federal Trade Commissions Rules. The device of Buonassissi substantially discloses the claimed invention but is lacking pictorial instructions that are permanently secured to the interior of the garment. According to the Care Labeling Rule, care instructions must be permanently secured to the inside of textile wearing apparel. Effective, July 1, 1997 the Federal Trade Commission permits the use of symbols, in place of written instructions, to provide instruction as to the method of cleaning. Care symbols developed by the American Society of Testing and Materials (ASTM) show pictorial representation for utilizing the garment. It would have been obvious to one of ordinary skill in the art at the

time the invention was made to permanently secure pictorial instructions to the textile apparel garment of Buonassissi, since it is a federally mandated regulation. In regard to the instructions directing the individual to follow specific steps it is the position of the examiner that the limitations specifying how the garment is used is functional. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

6. Claims 16, 26 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buonassissi and The Federal Trade Commission as applied to claims 8 – 15, 17 – 25, 27 – 30, 34 – 43, and 45 – 48 above, and further in view of Steele et al. (US 5,146,625). The modified device of Buonassissi substantially discloses the claimed invention but is lacking an insert having multiple chambers. The device of Steele et al. discloses a thermal insert for a vest having multiple chambers within (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Buonassissi by incorporating multiple chambers as taught by Steele et al. in order to allow easier use of flexing (Column 4, lines 43 – 45).

Response to Arguments

7. Applicant's arguments filed 11/29/2006 have been fully considered but they are not persuasive.

8. Applicant submits that the device of Buonassissi fails to disclose at least one cavity positioned around each of the side areas. Applicant's claim language only requires that there be a plurality of cavities that are positioned in a chest area, a back area, around each of the side areas and near the shoulder areas. The applicant has not clearly defined the position of the cavities in relation to the garment, but in relation to a portion of the user's body. The position of these cavities in relation to the user's body will vary depending on the size of the user wearing the garment. Moreover, when interpreted in the broadest reasonable sense the device of Buonassissi discloses cavities located in areas including a chest, a back, an area located at the each side and near the shoulder. The side portions of Buonassissi are adjustable and can be configured so that the cavities 34 and 36 are within a close proximity meeting the limitations as applicant has recited. It is also noted that the cavities (32) are near the top of the shoulder areas when interpreted in the broadest reasonable sense. Applicant has not claimed a single cavity which extends around the side area of the garment.
9. In regard to applicant remarks regarding the rejection of Buonassissi in view of Steele and The Federal Trade Commission applicant states that the combined references fail to teach pockets extending around the side of the vest and pockets near the top of the shoulder areas. These recitations are taught by the prior art of Buonassissi as discussed above.
10. In regard to applicants arguments that the prior art of the Federal Trade Commission does not teach instructions for utilizing a garment but rather teaches instructions for caring or washing for a garment: it is the position of the examiner that

the prior art teaches permanently attaching instructions to a garment. Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. The applicants argument that the prior art is lacking identification which relates to "instructions for utilizing." The examiner states that the applicant's argument is not persuasive, as the recited difference in the prior art and the applicant's claimed invention does not result in a structural difference between the claimed invention and the combination of the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHALE L. QUINN whose telephone number is (571)272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L Quinn
Examiner
Art Unit 3765

/R. L. Q./
Examiner, Art Unit 3765

/Katherine Moran/

Primary Examiner, Art Unit 3765